

REMARKS

Status of Claims

Applicant respectfully requests reconsideration and allowance of all of the claims of the application. The status of the claims is as follows:

- Claims 9,11-12,14-15,17-18, 32, 34-39 and 41-49 are currently pending;
- Claims 1-8 and 20-31 are canceled herein;
- Claims 9, 12, 32, 35, 38, 39 and 41 are amended herein;
- New claims 47-49 are added herein;
- Claims 9, 32, 41 and 47 are independent.

Support for the amendments to the claims is found in the specification, for example, at least at paragraphs 0006, 0007, 0020, 0031, 0049 and 0068 of Applicant's published application, US2005/0202875.

Claim 17 Complies With § 112 1st Paragraph

Claim 17 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

With respect to the rejection of claim 17, Applicant respectfully notes that original claims 16 and 17 read as follows:

16. (Original): A method as recited in claim 9, wherein after the signing in, the user has access to one or more items selected from a group comprising a friends list and a notification.

17. (Original): A method as recited in claim 16, wherein the notification is selected from a group comprising a friend request and a cross-title game invitation.

Current claim 17 has had claim 16 incorporated, and now reads as follows:

17. (Previously Presented): A method as recited in claim 9, wherein after the silently signing in, ***the user has access to a notification selected from a group comprising a friend request and a cross-title game invitation to switch from an offline game to an online game***, wherein the offline game is played by players with access to the dedicated game console and wherein the online game allows the players to play the online game against one or more other players online (emphasis added).

Thus, the highlighted language of current claim 17 is fully supported by claims 16-17 as originally filed. Further, Applicant notes that this claim language and the portion "*to switch from an offline game to an online game*" is expressly supported by the written description at least at paragraph 0020 of Applicant's original specification, which reads as follows:

The following disclosure describes the silent sign-in for offline game titles. The signing-in (also referred to as logging-in herein) affords the user access to select online services such as an in-game notification, a cross-title game invitation, a friend request (e.g., inviting a user to become a friend), and/or data corresponding to a friends list which are traditionally only available to online titles with a signed-in user. Such access enables a gamer to readily switch from an offline game to an online game when the situation changes (e.g., a friend signs-in or issues an invitation to play an online game). Silently signing in generally indicates that a user of a console is automatically signed onto an online service without requiring action by a user of a console in an implementation. (emphasis added)

Thus, Applicant respectfully notes that paragraph 0020 expressly discloses, for example, that the silent sign-in affords the user of an offline game title access to in-

game notifications, and such access enables a friend to sign in and issue an invitation to the user to play an online game, and the access enables the user to readily switch from an offline game to an online game.

Additionally, Applicant respectfully notes that it is well established that there is no *in haec verba* requirement for the claims of a patent, as long as the claims are supported in the specification through express, implicit, or inherent disclosure. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.

In addition, with respect to the assertion at Page 3, lines 8-12 of the Office Action that “*Applicant’s specification explicitly discloses online games are games which allow users to send and receive messages and offline games are played by user(s) with access to the game console only*”, Applicant respectfully notes that this assertion is taken out of context from the Background of Invention which describes offline games ***without the benefit of Applicant’s invention***. Applicant’s invention, however, overcomes the described shortcomings in offline games by allowing a user of an offline game to be silently signed-in while playing the offline game, so that the user can receive online services, such as in-game notifications and cross-title game invitations for switching from the offline game to an online game (see, e.g., pars. 0004, 0006, and 0020).

Claim 17 Complies With § 112 2nd Paragraph

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicant respectfully traverses this rejection. The Examiner

states that "It is not clear how a user receives a notification if the user is playing an offline game." However, Applicant respectfully notes that paragraph 0020 of Applicant's specification includes:

The following disclosure describes the silent sign-in for offline game titles. ***The signing-in (also referred to as logging-in herein) affords the user access to select online services such as an in-game notification, a cross-title game invitation, a friend request (e.g., inviting a user to become a friend), and/or data corresponding to a friends list which are traditionally only available to online titles with a signed-in user. Such access enables a gamer to readily switch from an offline game to an online game when the situation changes (e.g., a friend signs-in or issues an invitation to play an online game).*** Silently signing in generally indicates that a user of a console is automatically signed onto an online service without requiring action by a user of a console in an implementation (emphasis added).

This paragraph clearly indicates that one method of receiving notification is through in-game notification while the user is playing an offline game title. Applicant further reminds the Examiner that if a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. *See, e.g., Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., 'in the same words'] to be sufficient").

Cited Documents

The following documents have been applied to reject one or more claims of the Application:

- **"Help for AOL Instant Messenger"**, retrieved on 01/23/2008, at
<<[http://web.archive.org/web/20010311192847/http://www.aol.com.au/site/websit
e/aolprodu...>>](http://web.archive.org/web/20010311192847/http://www.aol.com.au/site/websit
e/aolprodu...>>), pp 1-4
- **Shambroom**: Shambroom et al., U.S. Patent No. 5,923,756
- **"Help for AOL Instant Messenger"**, retrieved on 01/28/2008, at
<<[http://web.archive.org/web/20020202010817/http://www.aim.com/help_fa
q/inu
x/latest_linux.adp>>](http://web.archive.org/web/20020202010817/http://www.aim.com/help_fa
q/inu
x/latest_linux.adp>>), pp 1-6
- **Easley**: Easley et al., U.S. Patent Application Publication No. 2002/0142842
- **"AOL Instant Messenger"**, at
<<[http://web.archive.org/web/20010818081919/http://www.aol.com.au/site/websit
e/aolprodu...>>](http://web.archive.org/web/20010818081919/http://www.aol.com.au/site/websit
e/aolprodu...>>), AOL Australia Online Services, 2001, pp 1-2
- **Nishiumi**: Nishiumi et al., U.S. Patent No. 6,001,015
- **Randall Whitten**: Randall Whitten et al., U.S. Patent Application Publication No. 2002/0128068
- **Maehrio**: Maehrio et al., U.S. Patent Application Publication No. 2002/0062350
- **Pennock**: Pennock et al., U.S. Patent No. 6,807,532

Pennock is Disqualified as Prior Art under 35 USC §103(c)

The rejections of claims 43 and 46 are overcome by the invocation of 35 USC §103(c). In particular, the present Application was filed on March 12, 2004. Pennock was filed on February 29, 2000, and was first published on October 19, 2004, after the filing date of the present Application. Accordingly, Pennock would only qualify as prior art under 35 USC 102(e), if that section applied.

Further, the present Application and the Pennock reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity, namely, Microsoft Corporation of Redmond, WA.

See, for example, Reel 015110, Frame 0198 for the assignment of the present Application to Microsoft, and Reel 010847, Frame 0966 for the assignment of the Pennock reference to Microsoft. In view of the common ownership of the present Application and the Pennock reference, Applicant respectfully submits that the Pennock reference is disqualified as prior art for purposes of 103(a) due to the applicability of 103(c). Thus, Applicant respectfully submits that the rejections of claims 43 and 46 are overcome. Accordingly, for at least the foregoing reasons, Applicant respectfully asks the Examiner to hold dependent claims 43 and 46 allowable and to issue a Notice of Allowance of same.

Applicant further respectfully notes that any new rejection of claims 43 and 46 in the next Office Action would be a new ground of rejection, and **therefore, the next Office Action cannot be made final.**

Claim Rejections under 35 U.S.C. § 103(a)

Claims 9, 32, and 37-39 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over AIM 3/11/01 in view of Shambroom. Claims 34-36 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over AIM 3/11/01 in view of Shambroom and in further view of AIM 2/2/02. Claims 11-12, 14-15 and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Easley in view of AIM 3/11/01 as supported by AIM 2/2/02 and AIM 8/18/01 and in further view of Shambroom. Claim 41 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Easley in view of AIM 3/11/01 in view of Shambroom and in further view of Whitten.

Independent Claims 9 and 32

Applicant submits that the combination of AIM 3/11/01 with Shambroom does not teach or suggest at least the following elements, as recited in independent claim 9 (with emphasis added):

...determining if at least one user account is present on the dedicated game console for a user of an offline game title on the dedicated game console;

if the at least one user account is present, determining if automatic sign-in is enabled on the dedicated game console for the at least one user account; and

if automatic sign-in is enabled, silently signing in a most recently signed in user account onto an online service without requiring action by the user of the offline game title on the dedicated game console for effecting the signing in, wherein the silently signing in comprises:

opening a secure communication channel between the dedicated game console and a security gateway of a secure data center based on a security ticket obtained from a key distribution center;

establishing a security key configured to encrypt data transferred between the dedicated game console and the security gateway;
transmitting data packets between the dedicated game console and the secure data center via the security gateway;
registering a presence of the specific user account with a presence server inside the secure data center; and
responsive to registering the presence of the specific user account, **providing the user of the offline game title on the dedicated game console with access to online services available from the secure data center during use of the offline game title.**

In contrast, AIM 3/11/01 merely discusses that when an auto login box is selected, the user will automatically be signed on to AOL Instant Messenger (AIM) whenever the user double clicks the AIM icon on the user's desktop. Specifically, AIM 3/11/01 describes the following:

When you select "Save Password", you will also have the option to select the "Auto-login" box. With "Save Password" and "Auto-login" both selected, you will automatically be signed on to AOL Instant Messenger whenever you double-click on the AOL Instant Messenger icon on your desktop (AIM 3/11/01, page 2, lines 39-41 – emphasis added).

Thus, when the user of AIM double clicks the AIM icon, the AIM user is intending to go online, because an instant messaging service is only useful if the user is online and able to send and receive instant messages online. On the other hand, according to Applicant's claim 9, the user of **an offline game title** is silently signed on without requiring action by the user of the offline game title on the game console to effect the signing in. Accordingly, AIM 3/11/01 fails to teach or suggest **if automatic sign-in is enabled, silently signing in a most recently signed in user account onto an online service without requiring action by the user of the offline game title on**

the dedicated game console for effecting the signing in, as recited in Applicant's claim 9.

Shambroom and the other art of record fail to make up for the shortcomings in AIM 3/11/01 pointed out above. For example, Shambroom describes

Establishing the secure network connection between the client and the network server can use the Secure Sockets Layer (SSL) protocol. Obtaining client-authenticating information and securing the network connection between the network server and the destination server can use the Kerberos authentication protocol. Access to the destination server by authenticated users can be controlled by access control lists on the destination server (col. 5, lines 28-35).

However, Shambroom does not teach or suggest ***if automatic sign-in is enabled, silently signing in a most recently signed in user account onto an online service without requiring action by the user of the offline game title on the dedicated game console for effecting the signing in***, as recited in Applicant's claim 9. Instead, Shambroom is merely concerned with the specifics of establishing a secure connection. The other art of record is similarly deficient in teaching or suggesting the above-discussed limitation of Applicant's claim 9. Accordingly, Applicant respectfully submits that claim 9 is allowable over AIM 3/11/01, Shambroom and/or the other art of record for this aspect.

Furthermore, AIM 3/11/01, Shambroom, and/or the other art of record fail to teach or suggest ***determining if at least one user account is present on the dedicated game console for a user of an offline game title on the dedicated game console, or providing the user of the offline game title on the dedicated game console with access to online services available from the secure data center***

during use of the offline game title, as also recited in Applicant's claim 9. Applicant has been unable to discern any portion of AIM 3/11/01 that describes anything other than a user logging on to an instant messenger service by double clicking an icon. Thus, Applicant respectfully submits that AIM 3/11/01 fails to teach or suggest **determining if at least one user account is present on the dedicated game console for a user of an offline game title on the dedicated game console, or providing the user of the offline game title on the dedicated game console with access to online services available from the secure data center during use of the offline game title**, as recited in Applicant's claim 9.

Further, Applicant has been unable to discern any portion of Shambroom that describes anything regarding these limitations. As discussed above, Shambroom is merely directed to establishing a secure connection (e.g., col. 5, lines 28-30). Thus, Shambroom also does not teach or suggest **determining if at least one user account is present on the dedicated game console for a user of an offline game title on the dedicated game console, or providing the user of the offline game title on the dedicated game console with access to online services available from the secure data center during use of the offline game title**, as also recited in Applicant's claim 9. Accordingly, Applicant respectfully submits that claim 9 is allowable over AIM 3/11/01, Shambroom, and/or the other art of record for these limitations as well.

In view of the foregoing, Applicant respectfully submits that claim 9 is allowable over AIM 3/11/01, Shambroom and/or the other art of record, and is in condition for allowance. Applicant respectfully asks the Examiner to withdraw the rejection of claim 9. Accordingly, for at least the foregoing reasons, Applicant

respectfully asks the Examiner to hold independent claim 9 allowable and to issue a Notice of Allowance of same.

Independent claim 32 includes subject matter similar to that discussed above with reference to claim 9, and is allowable under a similar rationale. Accordingly, for at least the foregoing reasons, Applicant respectfully asks the Examiner to hold independent claim 32 allowable and to issue a Notice of Allowance of same.

Independent Claim 41

Independent claim 41 includes limitations similar to claim 9 discussed above, and is allowable under a similar rationale. Further, Applicant submits that the combination of AIM 3/11/01 with Shambroom does not teach or suggest at least the following additional elements, as recited in independent claim 41 (with emphasis added):

...coupling a controller to one of a plurality of controller support subassemblies of the dedicated game console, wherein the dedicated game console comprises:

a video processing pipeline for graphics processing, the video processing pipeline comprising a three-dimensional graphics processing unit, a video encoder, and a digital video bus configured to carry data from the three-dimensional graphics processing unit to the video encoder; and

the plurality of controller support subassemblies, each controller support subassembly supporting a plurality of controllers;

following coupling of the controller to one of the plurality of controller support subassemblies, determining, by the dedicated game console, if a memory unit of the controller includes specific user account information corresponding to a specific user account of a user of an offline game title;

when the memory unit of the controller includes specific user account information corresponding to the specific user

account, silently signing in the specific user account onto an online service, wherein the silently signing in comprises:

opening a secure communication channel between the dedicated game console and a security gateway based on a security ticket obtained from a key distribution center;

establishing a security key configured to encrypt data transferred between the dedicated game console and the security gateway;

transmitting data packets between the dedicated game console and a secure data center, the data center accessible via the security gateway;

registering a presence of the specific user account by a presence server inside the secure data center;

responsive to registering the presence of the specific user account, providing a user of the dedicated gaming console with access to an online service available from the secure data center;

after the signing in, providing the user of the offline game title access to a friends list comprising a name of friends, an online or offline status of each one of the friends, a game each one of the friends is playing, and a voice-enabled status of each one of the friends; and

after the signing in, transmitting voice data and other data in data packets between the gaming device and the secure data center, wherein the data packets transmitting voice data are partially encrypted so that the voice data remains unencrypted and the other data is encrypted.

Easley describes a console system for operating at a central server in communication with remote user devices (e.g., par. 0018). However, after a review of Easley, Applicant has been unable to discern any portion of Easley that teaches or suggests ***following coupling of the controller to one of the plurality of controller support subassemblies, determining, by the dedicated game console, if a memory unit of the controller includes specific user account information corresponding to a specific user account of a user of an offline game title***, as recited in Applicant's claim 41. Applicant has further been unable to locate any portion of Easley that teaches or suggests that ***when the memory unit of the controller***

includes specific user account information corresponding to the specific user account, silently signing in the specific user account onto an online service, as also recited in Applicant's claim 41.

Further, Randall Whitten describes game controllers with memory units that can be coupled to a game console (e.g., FIG. 2). For example, Randall Whitten describes the following:

Eight memory units 140(1)-140(8) are illustrated as being connectable to the four controllers 104(1)-104(4), i.e., two memory units for each controller. Each memory unit 140 offers additional storage on which games, game parameters, and other data may be stored. When inserted into a controller, the memory unit 140 can be accessed by the memory controller 202. Additionally, one or more memory units 140 may be inserted into game console 102 and accessed by the memory controller 202 (par. 0036).

However, Randall Whitten does not teach or suggest, ***following coupling of the controller to one of the plurality of controller support subassemblies, determining, by the dedicated game console, if a memory unit of the controller includes specific user account information corresponding to a specific user account of a user of an offline game title, and when the memory unit of the controller includes specific user account information corresponding to the specific user account, silently signing in the specific user account onto an online service,*** as recited in Applicant's claim 41. For example, Randall Whitten describes game parameters and other data, but does not teach or suggest ***account information corresponding to a specific user account of a user of an offline game title,*** as recited in Applicant's claim 41. Randall Whitten further fails to teach or suggest that when such account information is included in the memory unit, ***silently signing in the***

specific user account onto an online service. Accordingly, the above limitations of claim 41 are not taught by Randall Whitten as well.

AIM 3/11/01, Shambroom and/or the other art of record fail to make up for the shortcomings in Easley and Randall Whitten pointed out above. For example, AIM 3/11/01 merely discusses that when an auto login box is selected, the user will automatically be signed on to AOL Instant Messenger (AIM) whenever the user double clicks the AIM icon on the user's desktop. Further, Shambroom is merely concerned with the specifics of establishing a secure connection. The other art of record is similarly deficient in teaching or suggesting the above-discussed limitations of Applicant's claim 41. Accordingly, Applicant respectfully submits that claim 41 is allowable over Easley, AIM 3/11/01, Shambroom and/or the other art of record for this aspect.

Furthermore, Easley, Randall Whitten, AIM 3/11/01, Shambroom, and/or the other art of record fail to teach or suggest ***after the signing in, providing the user of the offline game title access to a friends list comprising a name of friends, an online or offline status of each one of the friends, a game each one of the friends is playing, and a voice-enabled status of each one of the friends, or after the signing in, transmitting voice data and other data in data packets between the gaming device and the secure data center, wherein the data packets transmitting voice data are partially encrypted so that the voice data remains unencrypted and the other data is encrypted***, as also recited in Applicant's claim 41. Easley merely describes a console system for operating at a central server in communication with remote user devices (e.g., par. 0018). Randall Whitten describes game controllers with

memory units that can be coupled to a game console (e.g., FIG. 2). Further, as discussed above, Applicant has been unable to discern any portion of AIM 3/11/01 that describes anything other than a user logging on to an instant messenger service by double clicking an icon (page 2, lines 39-41). Additionally, as discussed above, Shambroom is merely directed to establishing a secure connection (e.g., col. 5, lines 28-30). Accordingly, Applicant respectfully submits that claim 41 is allowable over Easley, AIM 3/11/01, Shambroom, and/or the other art of record for these limitations as well.

In view of the foregoing, Applicant respectfully submits that claim 41 is allowable over Easley, Randall Whitten, AIM 3/11/01, Shambroom and/or the other art of record, and is in condition for allowance. Applicant respectfully asks the Examiner to withdraw the rejection of claim 41. Accordingly, for at least the foregoing reasons, Applicant respectfully asks the Examiner to hold independent claim 41 allowable and to issue a Notice of Allowance of same.

Independent Claim 47

Independent claim 47 includes limitations similar to claim 9 discussed above, and is allowable under a similar rationale. Further, Applicant submits that the combination of AIM 3/11/01 with Shambroom does not teach or suggest at least the following additional elements, as recited in independent claim 47 (with emphasis added):

...coupling a controller to the dedicated game console, the controller including a memory unit containing specific account information corresponding to a specific user account of a user of an offline game title;

following the coupling the controller to the dedicated game console, determining, by the dedicated game console, from the specific account information on the controller whether silent sign-in is enabled for the specific user account on the controller;

when automatic sign-in is enabled, silently signing-in the specific user account onto an online service without requiring action by the user of the offline game title;

after the signing-in, receiving an in-game notification by the user of the offline game title; and

switching by the user of the offline game title from an offline game to an online game, wherein the offline game is played by players with access to the dedicated game console and wherein the online game is played against one or more other players online.

For the reasons discussed above with respect to claim 41, the art of record fails to teach or suggest ***following the coupling the controller to the dedicated game console, determining, by the dedicated game console, from the specific account information on the controller whether silent sign-in is enabled for the specific user account on the controller, or, when automatic sign-in is enabled, silently signing-in the specific user account onto an online service without requiring action by the user of the offline game title***, as recited in Applicant's claim 47. For example, Easley merely describes a console system for operating at a central server in communication with remote user devices (e.g., par. 0018).

Additionally, Randall Whitten describes game parameters and other data in a memory unit, but does not teach or suggest ***determining, by the dedicated game console, from the specific account information on the controller whether silent sign-in is enabled for the specific user account on the controller***. Randall Whitten further fails to teach or suggest, ***when automatic sign-in is enabled, silently signing-***

in the specific user account onto an online service without requiring action by the user of the offline game title. Accordingly, these limitations of claim 47 are also allowable over Randall Whitten.

Further, as discussed above, Applicant has been unable to discern any portion of AIM 3/11/01 that describes anything other than a user logging on to an instant messenger service by double clicking an icon (page 2, lines 39-41). Additionally, as discussed above, Shambroom is merely directed to establishing a secure connection (e.g., col. 5, lines 28-30). Accordingly, Applicant respectfully submits that claim 47 is allowable over Easley, Randal Whitten, AIM 3/11/01, Shambroom, and/or the other art of record for these limitations.

In addition, Applicant's claim 47 also includes, ***after the signing-in, receiving an in-game notification by the user of the offline game title, and switching by the user of the offline game title from an offline game to an online game, wherein the offline game is played by players with access to the dedicated game console and wherein the online game is played against one or more other players online.*** As discussed above, Easley, Randall Whitten, AIM 3/11/01, Shambroom, and/or the other art of record fail to teach or suggest these limitations as well.

In view of the foregoing, Applicant respectfully submits that claim 47 is allowable over Easley, Randall Whitten, AIM 3/11/01, Shambroom and/or the other art of record, and is in condition for allowance. Applicant respectfully asks the Examiner to withdraw the rejection of claim 47. Accordingly, for at least the foregoing reasons, Applicant respectfully asks the Examiner to hold independent claim 47 allowable and to issue a Notice of Allowance of same.

Dependent Claims

In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

Conclusion

Applicant submits that all pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the Examiner is urged to contact the undersigned representative for the Applicant before issuing a subsequent Action.

Respectfully Submitted,

Lee & Hayes, PLLC
Representative for Applicant

/Colin D. Barnitz/ Dated: June 5, 2009
Colin D. Barnitz(colin@leehayes.com; 512-505-8162 x5002)
Registration No. 35061

Reviewer/Supervisor: Emmanuel A. Rivera
(emmanuel@leehayes.com; 512-505-8162 x5001)
Registration No. 45760